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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,419	03/20/2006	Gianfranco Passoni	NIRSP177	1171
20210 7590 08/18/2009 DAVIS & BUJOLD, P.L.L.C. 112 PLEASANT STREET CONCORD, NH 03301				
EXAMINER PARADISO, JOHN ROGER				
ART UNIT		PAPER NUMBER		
3721				
MAIL DATE		DELIVERY MODE		
08/18/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/572,419

**Applicant(s)**

PASSONI, GIANFRANCO

**Examiner**

John Paradiso

**Art Unit**

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 49-51 and 53-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 49-51, 53-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Request for Continued Examination***

1. The request filed on 6/23/2009 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/572,419 is acceptable and a CPA has been established. An action on the CPA is attached.

2. On page 7 of his Response, Applicant requests a telephone interview. Applicant is invited at his earliest convenience to call the Examiner at (571) 272-4466 to schedule an interview.

***Claim Rejections***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 49-51 and 53-66 are rejected under 35 U.S.C. § 103(a) as being unpatentable over MILLER (US 4524691) in view of BELEC ET AL (US 5447015) and BUTTON ET AL (US 6199348).

MILLER discloses a method and apparatus for opening envelopes. Envelopes are held in a magazine (29) (see Fig. 6) where they are grabbed by a rotating cam (47) (see column 5:25-28), pulled off the cam and rotating drum (36) by means of a stripper bar (see Fig. 6), and conveyed to a filling station.

MILLER does not disclose the envelopes having items inserted therein. Miller also does not disclose the drum having suction, nor does it disclose an air stream used to open the envelopes.

BELEC ET AL discloses a method and apparatus for packing envelopes in which envelopes are carried by a vacuum drum (30) with frictional coatings and vacuum apertures. (see Fig 1 and column 3:60-4:25). The envelopes are pulled from the drum by an oscillating suction gripper. The envelopes are filled at an envelope inserting station (10).

BUTTON ET AL discloses a method and apparatus for packing envelopes in which a flap opening means (28) opens the flap in preparation of inserting items into the envelop by dispensing a compressed air stream to open it (see Fig. 3A and column 7:27-39). An envelope packing assembly is disclosed (see Fig. 7A-7D and column 15:66 - 16:56) in which items are guided into the open envelopes.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of MILLER by adding an insertion station, as taught by BELEC ET AL, in order to provide greater utility for the invention. It would also have been obvious to one of ordinary skill in the art at the time the invention was made to by making the pickup drum a suction-assisted drum, as taught by BELEC ET AL, in order to more positively control the envelopes during the process.

It would further have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of MILLER and BUTTON ET AL by adding an air stream, as taught by BUTTON ET AL, in order to more quickly and completely open the envelopes and to provide them to the control drum in an open and ready-to-fill state.

***Response to Arguments***

5. Applicant's arguments filed 6/23/2009 have been fully considered but they are not persuasive.
6. Applicant states on page 8 of his Response that "Turning now to the base reference of Miller'691, this reference relates to a device which has a design that is apparently somewhat similar to the device of the present invention but which is, in fact, completely different from the presently claimed invention. In particular, Miller '691 fails to disclose a method or an apparatus for opening envelopes and inserting items therein."

However, this argument is considered moot in view of the new grounds of rejection above.

7. Applicant states on page 8 of his Response that "In addition, it is respectfully submitted that the envelopes are not "grabbed" by a "rotating cam," as suggested in the official action, but instead are "grabbed" by suction cups 34, 35 which generally comprises complex mechanical elements. Only once the envelopes are positioned by the suction cups 34, 35 does the "rotating cam" contact the envelopes and press them toward the rotating drum 36 for further conveyance."

However, since there is no negative limitation in the claims regarding intervening or concurrent operations or parts, this is immaterial. Examiner maintains that while there are differences between the combination of the prior art and the claims of the instant invention, the claims of the instant invention still read on the prior art.

8. Applicant states on page 8-9 of his Response that "With respect to Belec et al. '015, it is respectfully submitted that this reference specifically discloses that the vacuum drum 30 is static and does not rotate-see Figs. 19 and 20 and column 8 lines 33-35 and 53-56-and only serves to hold down the closing flap of the envelopes and, unlike the presently claimed invention, does not actually convey the envelopes. Instead, the envelopes in Belec et al. '015 are transported by belts running along part of the outside of the vacuum drum 30 but "do not necessarily make contact with disks 32 or solid disks 33" of the vacuum drum 30 (see column 9 lines 8-9)."

However, this is irrelevant since a rotating drum is disclosed by MILLER and it is this that the feature of the claims is being read on.

9. Applicant states on page 9 of his Response that "In addition, and as somewhat alluded to above, it is respectfully submitted that due to the multiplicity of movable components of Belec et al. "015--such as a suction cup 78, rotating fingers 52, continuously moving envelope transport belts 60, and a separate envelope stacking section--this complicates operation of the device and thus tends to reduce its overall speed and efficiency. The Applicant respectfully submits that the presently claimed invention possesses a distinct and patentable advantages and improvements over and above the applied art of Belec et al. "015 because the presently claimed invention requires fewer complex moving components and can operate at higher output speeds.."

However, while this may be true, it is irrelevant since it has been held that omission of an element and its function in a combination where the remaining elements perform the same function as before involves only routine skill in the art.

10. Applicant states on page 9 of his Response that "With respect to the applied Button et al. "348 reference, the Applicant respectfully draws the Examiner's attention to the fact that independent claims 49, 65 and 66 are each distinguishable over and from Button et al. "348 because, while Button et al. "348 specifically teaches opening the envelopes by using a stream of air, this reference fails to in any way teach, suggest, disclose or remotely hint at, in any way, of utilizing a rotary cam to assist with the envelope opening process. Accordingly, the Applicant respectfully submits that Button et al. "348 fails to cure and/or supply the missing features which are lacking from in the applied combination of Miller "691 and Belec et al. "015."

However, these features are supplied by MILLER, as described above.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center Receptionist.

/John R Paradiso/

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Examiner John Paradiso: (571) 272-4466

August 16, 2009

Additional Phone Numbers:

Supervisor Rinaldi Rada: (571) 272-4467

Fax (Official): (571) 273-8300

Fax (Direct to Examiner) (571) 273-4466 (Drafts only)